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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,444	07/09/2001	Robert L. Horton	05542/009002	7706
22511	7590	09/08/2004	EXAMINER	
OSHA & MAY L.L.P. 1221 MCKINNEY STREET HOUSTON, TX 77010			TUCKER, PHILIP C	
		ART UNIT		PAPER NUMBER
		1712		

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/901,444	HORTON ET AL.
	Examiner Philip C Tucker	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,14-16 and 18-21 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,14-16 and 18-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 14-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quattrini (3660287).

Quattrini teaches a water based fluid which is used to remove deposits from wells, which comprises an ethanol amine and polyethylene glycol (see Examples 1 and 3). Triethanolamine is explicitly taught as being alternatively used instead of the monoethanol amine of the examples, and its use would be instantly envisaged by one of ordinary skill in the art (column 2, lines 48-53). Quattrini differs from the present invention in that the addition of a composition comprising the amine and polyethylene glycol to the fluid is not disclosed. However the addition of a combination of the amine and polymer to the fluid would be obvious to one of ordinary skill in the art, since an order of mixing ingredients is not a patentable distinction (*In re Hampel* 74 USPQ 171). The use of "consisting essentially of" does not distinguish, since a well fluid is still produced.

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3. Claims 1-6, 14, 15 and 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanlon (4524829).

Hanlon teaches a wellbore fluid which comprises a polyacrylamide synthetic polymer and triethanolamine, within the scope of the present invention (see Table I and column 5, lines 33-50). Hanlon differs from the present invention in that the addition of a composition comprising the amine and polymer to the fluid is not disclosed. However the addition of a combination of the amine and polymer to the fluid would be obvious to one of ordinary skill in the art, since an order of mixing ingredients is not a patentable distinction (*In re Hampel* 74 USPQ 171). The use of "consisting essentially of" does not distinguish, since a well fluid is still produced.

1. Claims 1-4, 14, 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over RD 249047.

RD 249047 teaches a method of stabilizing a wellbore fluid containing hydroxypropyl guar with triethanolamine, and other amines. Hydroxypropyl guar is a synthetic polymer, since it is made by hydroxypropylation of guar gum. The triethanolamine is at a level of 0.5%, which anticipates the "about 0.6%" of the current claims. Hanlon differs from the present invention in that the addition of a composition comprising the amine and polymer to the fluid is not disclosed. However the addition of a combination of the amine and polymer to the fluid would be obvious to one of ordinary skill in the art, since an order of mixing ingredients is not a patentable distinction (*In re*

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Hampel 74 USPQ 171). The use of "consisting essentially of" does not distinguish, since a well fluid is still produced.

4. Claims 1-6, 14, 15 and 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Glass Jr. (4486340).

Glass teaches a wellbore fluid which comprises a polyacrylamide synthetic polymer and triethanolamine, within the scope of the present invention (see column 19, lines 8-15). Glass teaches that the amine stabilizes the polymer (column 10, lines 51-68) and is used in amounts within the scope of the present invention. Glass differs from the present invention in that the addition of a composition comprising the amine and polymer to the fluid is not disclosed. However the addition of a combination of the amine and polymer to the fluid would be obvious to one of ordinary skill in the art, since an order of mixing ingredients is not a patentable distinction (In re Hampel 74 USPQ 171).

2. In the previous office action applicant's claim for domestic priority to 60/297,491 was informally acknowledged. The patent office no longer officially acknowledges claims for domestic priority to provisional applications, thus it is applicants duty to see that the proper papers were filed. It is noted that no arguments were presented with respect to the RD reference presented in the previous office action. Applicant's arguments with respect to Quattrini have been considered but are not deemed

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persuasive. Applicant has argued that Quattrini does not teach a polymer. Applicants claim 16 is directed to the same polymer, polyethylene glycol as Quattrini, thus no difference is seen. Since a well fluid is produced, the “term consisting essentially of” cannot distinguish over Quattrini. Similarly with respect to Hanlon, such term cannot distinguish because a well fluid is still formed. The same level of amine is used in the reference compositions, which would obviously lead to similar stabilization. In view of applicants amendment to state “consisting essentially of”, a new rejection is presented over Glass.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3111